

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

APPLICANT: Peter W. Fajkowski TITLE: Method and Apparatus for Coupon Management and Redemption
SERIAL NO.: 09/297,532 ART UNIT: 2876
FILING DATE: June 28, 1999 EXAMINER: St. Cyr, D.
DOCKET NO.: 8958.004

Supplemental Brief in Support of Appeal

The Honorable Commissioner of
Patents and Trademarks
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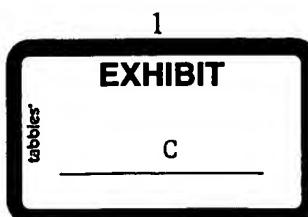
Dear Sir:

This revised brief is filed pursuant to the office action mailed on May 29, 2002, in which the examiner reopened prosecution in response to applicant's revised brief. The applicant's supplemental brief was originally due on August 29, 2002. The applicant hereby requests a three (3) month extension of time in which to file this supplemental brief. A check in the amount of \$460.00 to cover the extension fee is submitted herewith. No additional fees are believed to be due at this time; however, if any are due the Commissioner is authorized and respectfully requested to charge the same to deposit account no. 18-2210.

The examiner's rejections are respectfully traversed, and the Board is respectfully requested to reverse the examiner's rejections of the applicant's claims for the reasons detailed below.

I. Real Party in Interest

The real party in interest is Peter W. Fajkowski.



II. Related Appeals and Interferences

None.

III. Status of Claims

Claims 1-24 Canceled by preliminary amendment

Claims 26-41 Canceled by preliminary amendment

IV. Status of Amendments

No amendments have been filed subsequent to the entry of the final office action; however, the applicant wishes to cancel claims 25 and 42, without prejudice.

V. Summary of the Invention

There are three separate independent claims at issue in this appeal. The preferred embodiment of the invention to which claim 43 is directed is an adapter 350 for converting recorded data on a disk to electrical data for wireless transmission to a storage device such as coupon card 1. The adapter 350 has a body 358 appropriately sized to fit in a disk drive 360. The body 358 has an insertion port 354 for receiving the storage device and a memory 352 for receiving the recorded data. There is also a wireless transmitter on the body 358 for receiving and transmitting the electrical data in a wireless signal. Finally, the body 358 contains a processor 353 for converting the recorded data into electrical data so that it can be transmitted by the wireless transmitter. The preferred embodiment of the adapter 350 is described in the specification starting on page 39 at line 26 and is illustrated in figures 19a and 19b.

The preferred embodiment of the invention to which claim 46 is drawn is an apparatus for telephonically distributing electronic coupon data to a coupon storage device, such as coupon card 1. The apparatus has a port 405 sized to receive a coupon storage device. It also has a modem 416 for telephonically receiving electronic coupon data and a microprocessor 425 controlling the receipt and transfer of the coupon data. The apparatus also has a random access memory 417 that interacts with the microprocessor 425 and a telephonic subcomponent that includes a telephone keypad 401. The preferred embodiment of this invention is described in the specification starting on page 41 at line 18 and is illustrated in figures 20a and 20b.

Finally, the preferred embodiment of the invention to which claim 53 is drawn is a system for transferring coupon data from a computer to an electronic coupon card 1. The electronic coupon card 1 has a microprocessor 25 and circuitry for receiving and storing coupons as well as receiving elements, such as communications port 14. The system also includes an adapter 350 that has three parts: an adapter body 358; a reader, such as magnetic head 357; and a processor 353. The adapter body 358 has transmitting elements and is configured to align the receiving elements of the coupon card with the transmitting elements of the adapter body 358 so that they can communicate with each other. The reader is operatively connected to the adapter body 358. It allows the adapter 350 to receive coupon data from an outside computer. Finally, the processor 353 receives coupon data from the reader and transfers the coupon data to the coupon card 1 where it is stored. A description of the preferred embodiment of the adapter 350 can be found in the specification at page 39 beginning at line 26 and is illustrated in figures 19a and 19b. A description of the preferred embodiment of the coupon card 1 can be found in the specification at page 10 beginning at line 22 and is illustrated in figures 1-6.

VI. Issues

1. Whether the examiner has established a *prima facie* case that claims 43-44 are obvious under 35 U.S.C. § 103 over U.S. Patent 5,663,553 in view of U.S. Patent 5,831,547.
2. Whether the examiner has established a *prima facie* case that claims 45 and 47 are obvious under 35 U.S.C. § 103 over U.S. Patent 5,250,789 in view of U.S. Patent 5,663,553.
3. Whether the examiner has established a *prima facie* case that claims 46-52 are obvious under 35 U.S.C. § 103 over U.S. Patent 5,250,789 in view of U.S. Patent 5,663,553.
4. Whether the examiner has established a *prima facie* case that claim 53 is obvious under 35 U.S.C. § 103 over U.S. Patent 5,250,789 in view of U.S. Patent 5,663,553.

VII. Grouping of the Claims

The claims may be properly grouped as follows:

1. Claims 43-44. These claims do not rise or fall with any other claims.
2. Claims 45 and 47. These claims do not fall with any other claims, although they may stand if the independent claims on which they depend are found to be allowable.
3. Claims 46 and 48-52. These claims do not rise or fall with any other claims.
4. Claim 53. This claim does not rise or fall with any other claim.

VIII. Argument

A. The Examiner's Objections to the Informalities

The examiner's objections to the claim language is acceded to. The applicant respectfully requests that the examiner enter an examiner's amendment corresponding to the requirements set out on page 1 of the April 17, 2001, office action or that the case be remanded to the examiner to allow the applicant to submit the appropriate amendments, after the Board addresses the merits of

the appealed rejections.

B. Claims 43-45

Claim 43 is independent. Claims 44 and 45 depend from 43. Claim 43 is set out below.

43. An adapter for converting recorded data on a disk device to electrical data for wireless transmission of the contents of said recorded data to a storage device, said adapter comprising:

- a. an adapter body sized to be inserted in a disk drive;
- b. an insertion port formed on said body for receiving said storage device;
- c. a memory on said body for receiving the contents of said recorded data;
- e. a wireless transmitter on said body for receiving electrical data and transmitting said electrical data in a wireless signal; and
- f. a processor on said body for converting the contents of said recorded data into electrical data which may be transmitted through said wireless transmitter.

Claims 43 and 44 have been rejected under 35 U.S.C. § 103 in view of U.S. Patent 5,663,553 to Aucsmith (“Aucsmith”) and U.S. Patent 5,831,547 to Ohtsuki, *et al.* (“Ohtsuki”).

To establish a *prima facie* case of obviousness based upon the combination of two or more references, the examiner must establish that there is a motivation to combine the references and that the combined references teach or suggest all of the limitations of the claims. MPEP §§ 2143.01, 2143.03. The teaching or suggestion to make the combination must be found in the prior art, not the applicant’s disclosure. MPEP § 2143.

As the examiner has conceded, Aucsmith does not disclose a wireless transmitter for receiving electrical data and transmitting said electrical data in a wireless signal. The examiner has cited Ohtsuki in an attempt to satisfy this limitation. However, the examiner has cited nothing in the prior art which suggests a reason to combine Aucsmith and Ohtsuki. Rather, the examiner’s entire effort in this regard consists of following lines:

In view of Ohtsuki's teaching, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to modify the system of Aucsmith into a wireless system *to provide a more versatile system with easier system setup and maintenance. Such modification would eliminate wear and tear in the portable storage device which would improve the overall system's reliability and quality.*

May 29, 2002 Office Action, p. 4 (Paper No. 18)(emphasis added).

The italicized language is the only rationale provided by the examiner for combining the teachings of Aucsmith and Ohtsuki. Significantly, none of it comes from the prior art. There is nothing in Aucsmith that suggests that the invention disclosed therein is somehow lacking in versatility, nor does the examiner identify any feature of Aucsmith whose versatility would be improved by the combination. In fact, the applicant has no idea what the examiner means when he writes of improved versatility. What will be more versatile because of the combination? The applicant cannot tell from the examiner's statement.

The examiner also mentions "set up" and "maintenance." However, he does not identify anything in Aucsmith that must be set up or maintained, much less explain what about the Aucsmith set and maintenance procedures require improvement. The examiner also omits any discussion of how combining Ohtsuki with Aucsmith would alleviate the unidentified set up and maintenance problems.

Finally, the examiner indicates that combining Aucsmith with Ohtsuki would "eliminate wear and tear." Again, the worn and torn components of Aucsmith are not identified. No discussion is provided of their shortcomings or of how the combination of Aucsmith and Ohtsuki would prevent the mysterious wear and tear. Rather the examiner has merely opined that the combination would improve "reliability and quality," without explaining what he means by either of these subjective and relative terms.

The examiner has not cited any basis *in the prior art* for combining the teachings of Aucsmith and Ohtsuki. Rather, he has used the applicant's claims as a template to piece together the prior art. Without a reason for the combination that comes from the prior art, the examiner has not met his *prima facie* burden, and the rejection should be withdrawn. MPEP § 2143. Accordingly, claim 43 should be allowed. Likewise, claims 44-45, which depend upon claims 43, should be allowable as well.

C. Claim 45 and 47

Claim 45 is a dependent claim which requires the wireless transmitter of claims 43 and 44 to include "a light emitting diode and a light responsive transistor." Claim 47 is also a dependent claim which adds similar limitations to the apparatus of claim 46. The examiner has rejected both claims under 35 U.S.C. § 103 as being obvious in view of U.S. Patent 5,250,789 to Johnson ("Johnson") and Aucsmith. However, the examiner is apparently under the mistaken belief that the limitations recited in claims 45 and 47 are merely used to indicate whether the devices of the respective claims are present or absent from a port. To the contrary, "the light emitting diode and the light responsive transistor" are a specific type of data transmitter. The diode transmits signals by emitting light. The transistor reads these signals by responding to the light emitted by the diode. This is clear from claims 45 and 47 themselves and from the specification. *See*, Specification, p. 40, ln. 22 -- p. 41, ln. 17.

The examiner has not made any attempt to show that the limitations of claims 45 or 47 are taught in the prior art. In the absence of such a showing, the examiner has not met his *prima facie* burden, and his rejection of claims 45 and 47 should be withdrawn. MPEP § 2143.

D. Claims 46-52 and 53

Claim 46 is an independent claim. It is reproduced below.

46. An apparatus for the telephonic distribution of electronic coupon data to a storage device, said apparatus comprising:

- a. an insertion port for receiving a coupon storage device;
- b. a modem for telephonically receiving electronic coupon data;
- c. a microprocessor controlling the receipt and transfer of electronic coupon data;
- d. a random access memory interacting with said microprocessor; and
- e. a telephonic subcomponent including a telephone keypad.

Claims 47 through 52 depend on claim 46.

Claim 53 is an independent claim. It is reproduced below.

53. A system combining an electronic coupon card with an adapter for transferring coupon data from another computer to said coupon card, said system comprising:

- a. an electronic coupon card having a microprocessor and circuitry for receiving and storing coupons;
- b. an adapter having:
 - i. an adapter body configured to receive and align receiving elements of said coupon card with transmitting elements of said adapter body;
 - ii. a reader operatively connected to said adapter body and allowing said adapter to receive coupon data from another computer; and
 - iii. a processor for receiving coupon data from said reader and transferring said coupon data to said coupon card for storage thereon.

The examiner has rejected claims 46 and 53 as being obvious under § 103 over Johnson in view of Aucsmith. To establish a *prima facie* case of obviousness based upon the combination of two or more references, the examiner must establish first that there is a motivation to combine the references and second that the combined references teach or suggest all of the limitations of the claims. MPEP §§ 2143.01, 2143.03. The teaching or suggestion to make the combination must be

found in the prior art and not the applicant's disclosure. MPEP § 2142. Additionally, if the proposed modification would render the prior art device being modified unsatisfactory for its intended purpose, there is no suggestion to make the proposed modification. MPEP § 2143.01

In an effort to establish a basis for combining Aucsmith and Johnson the examiner has stated only:

In view of the disclosure of Aucsmith above, it would have been obvious for an artisan at the time the invention was made to employ the portable device of Aucsmith into the system of Johnson so that shoppers can securely personalizing (sic) their shopping list into smart cards before going to market which would expedite the shopping process wherein customers could just load their personalized information into the store's system to make their products' (sic) selection. Such modification would allow customers to better plan and budget their shopping.

May 29, 2002 Office Action, pp. 5-6 (Paper No. 18).

Johnson is configured to read data on a floppy disk. Johnson, Col. 5, ll. 60-64. There is no mention in Johnson anywhere of smart cards or smart card compatibility. If a shopper personalized his shopping list into smart card as the examiner suggests, the device of Johnson would not be able to read it when the shopper arrived at the store. If a modification would render a device incompatible with its intended purpose, there is no suggestion to make the modification. MPEP § 2143.01.

Moreover, the examiner has indicated that the motivation for his combination of Johnson and Aucsmith is to allow shoppers to securely personalize their shopping list into smart cards before going to market. The examiner has provided no citation to anything *in the prior art* which would suggest why a shopper using the Johnson device would want to personalize their shopping list onto a smart card. The examiner has provided several such reasons, but they have no basis in the prior art. Rather, they appear to simply have been manufactured by the examiner as a hindsight

justification for his combination. In the absence of a basis for combining the references that exists in the prior art, the examiner has not met his *prima facie* burden, and his § 103 rejection should be withdrawn.

Even if the combination of Aucsmith and Johnson were suggested in the prior art, the combination would not teach or suggest every limitation in claim 46. Claim 46 requires the claimed apparatus to contain a “a modem for telephonically receiving electronic coupon data.” This is a functional limitation specifically requiring that the modem be configured to receive electronic coupon data. Johnson discloses a modem; however, the only function disclosed for the modem in Johnson is to receive shopping lists from customers. Johnson, Col. 7, ll. 22-29. Nowhere in Johnson is there any disclosure regarding the use of a modem to send or receive *coupon data*. Aucsmith does not disclose coupon data or a modem. Thus, when the two references are combined, they do not teach or suggest the functional limitation that the modem be configured to receive coupon data. Therefore, the references do not teach or suggest all of the limitations of claim 46, even if they are combined, and the examiner has not met his *prima facie* case with respect to claim 46 and the claims that depend therefrom.

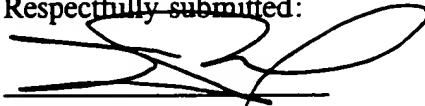
Claim 53 requires “an electronic coupon card having a microprocessor and circuitry for receiving and storing coupons.” Aucsmith discloses an electronic card having a microprocessor and circuitry; however, nothing in Aucsmith or Johnson suggests modifying either the microprocessor or the circuitry to receive or store coupons. More importantly, the examiner has not explained what in the prior art suggests such a modification. Therefore, the examiner has not met his *prima facie* case with respect to claim 53.

In view of the foregoing, all of the claims remaining in the application are believed to be

patentable over the art of record and an early notice of allowability is respectfully requested.

Respectfully submitted:

Dated: November 27, 2002


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